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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/156,886	09/18/1998	BERNHARD MUSSIG	101769-26/tesa 516.1	1668
27384	7590	03/18/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA			GOFF II, JOHN L	
875 THIRD STREET			ART UNIT	
18TH FLOOR			PAPER NUMBER	
NEW YORK, NY 10022			1733	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/156,886

Applicant(s)

MUSSIG, BERNHARD

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/28/05 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 37-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koga et al. (EP 661364) in view of Dobashi et al. (U.S. Patent 5,643,676).

Koga et al. disclose a self-adhesive protective film for protecting the surface of a substrate (e.g. a metal substrate) from corrosion, dust deposition, or damage during transport or storage. Koga et al. teach the film comprises a backing film and an adhesive layer. Koga et al. teach the protective film is produced by co-extruding the backing film and adhesive layer. Koga et al. teach the backing film comprises a multilayer structure wherein the base layer of the film is formed of  $\alpha$ -olefins and the layer contacting the adhesive layer is formed of  $\alpha$ -olefins such as propylene to form a strong bond with the adhesive layer, i.e. it acts as an adhesion promoting layer. Koga et al. teach the adhesive layer comprises a copolymer of at least two  $\alpha$ -olefins

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having 2 to 12 carbon atoms and at least one further comonomer including a diene. Koga et al. teach the diene comonomers comprise 0-50% by weight of the adhesive layer, and the diene comonomers are included for advantages such as lowering the glass transition of the adhesive layer, improving the low temperature adhesion characteristics, and providing an adjustable initial tack. Koga et al. teach the  $\alpha$ -olefinic copolymer content is preferably 15-70 mol% of any single  $\alpha$ -olefin. Koga et al. teach the adhesive layer further comprises standard additives including polar comonomers and crosslinking agents. Koga et al. further teach the protective film has a bond strength to steel of at least 0.7 N/cm (Page 2, lines 12-56 and Page 3, lines 30-36, 41-42, 45-50, 54-57 and Page 4, lines 19-25 and 30-50 and Page 5, lines 15-58 and Page 6, lines 1, 6-7, and 18-21). Koga et al. are silent as to specifically reciting the use of the protective film for protecting the paint finish of a vehicle, it being noted Koga et al. do not provide any specific uses other than for protecting a coated metal substrate from corrosion, dust deposition, or damage during transport or storage. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the protective film taught by Koga et al. to protect the paint finish of a vehicle as it was well known in the art to use protective films such as those taught by Koga et al. to protect the paint finish of a vehicle from corrosion, dust deposition, or damage during transport or storage as shown for example by Dobashi et al.

Regarding claims 37, 40, 42, 44, 47-49, 52, and 53, Koga et al. do not specifically recite the specific Mooney viscosity of the adhesive layer. However, the adhesive composition taught by Koga et al. is the same as that claimed and disclosed in applicants specification such that one of ordinary skill in the art would readily expect both compositions to have the same Mooney viscosity particularly in view of the wide range claimed, i.e. less than 50. Furthermore, as noted

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above Koga et al. disclose an adhesive composition (including a range of additives) that is not particularly limited such that it would have been obvious to one of ordinary skill in the art at the time the invention was made to experimentally determine/optimize specific properties of the adhesive, e.g. viscosity, adhesive force, etc., as a function of the specific composition used, e.g. amount of copolymer, amount diene, amount of polar comonomers, etc., as doing so would have required nothing more than ordinary skill and routine experimentation.

Regarding claims 41, 45, 46, and 50, Koga et al. are silent as to the backing film including light stabilizers. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the backing film taught by Koga et al. light stabilizers as it was well known in the art to include light stabilizers in the backing film to improve its weatherability as shown for example by Dobashi et al.

Dobashi et al. are directed to a self-adhesive protective film which is used to temporarily protect automotive coatings during transportation and storage of automobiles. Dobashi et al. teach the protective film comprises a backing film and an adhesive layer. Dobashi et al. teach the backing film includes light stabilizers (such as HALS in an amount of 0.1 to 5% by weight) to give the protective film a UV permeability in the range from 190 to 370 nm of less than 1%, i.e. the light stabilizers improve the weatherability of the protective film (Column 1, lines 5-8 and Column 2, lines 19-25 and 59-65 and Column 3, lines 27-33 and Column 4, lines 1-10 and Column 5, lines 57-59 and Column 7, lines 5-12).

*Response to Arguments*

4. Applicant's arguments filed 11/15/03 have been fully considered but they are not persuasive. Applicants argue Koga et al. do not recognize the criticality of the diene component. As noted previously, Koga et al. specifically teach incorporating a diene component for advantages such as lowering the glass transition of the adhesive layer, improving the low temperature adhesion characteristics of the film, and providing an adjustable initial tack. Therefore, clearly one of ordinary skill in the art would have included a diene component for these advantages, it being further noted the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

*Conclusion*

5. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is (571) 272-1216. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John L. Goff



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